

REMARKS

By this amendment, Applicants have amended claim 1 to include the features of claims 2 and 3. Claims 4, 6, and 8 have been amended as suggested by the Examiner. Claims 2, 3 and 11 have been canceled without disclaimer and Applicants reserve the right to pursue them in one or more continuation/divisional applications. These amendments do not add new matter. Applicants respectfully request entry of these amendments and allowance of the pending claims.

1. Substance of Interview

In responding to the Office Action, Applicants' representative, William Schmidt, conducted a telephone interview with Examiner Empie on July 21, 2011. Applicants thank the Examiner for the time generously extended during the interview. Applicants discussed during the interview amending the claims to include the features of claims 2 and 3 and an agreement was not reached and the Examiner would need to do further search and consideration.

2. Restriction Requirement

The Examiner considers claim 11 to be drawn to a non-elected invention. In response, Applicants have canceled claim 11 without disclaimer and reserve the right to pursue it in one or more continuation/divisional applications. Therefore, this restriction requirement is now moot.

2. Rejections Under 35 U.S.C. § 112 Second Paragraph

Claims 6, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph for reciting the term "re-suction." The Examiner recommends replacing this term with the term "suction." Claim 8 has been rejected for lacking antecedent basis for the term "carrier" and the Examiner recommends replacing this term with the term "body". In response, Applicants have amended these claims as recommended by the Examiner. Therefore, these rejections are now moot.

3. Rejections under 35 U.S.C. §103(a)

The Examiner rejects claims 1-3, 6 and 9 under 35 U.S.C. 103(a) as allegedly being unpatentable over US Patent Publication No. 2003/0044250 (Kiessling) in view of U.S. Patent No. 3,959,520 (Hoyer). Claim 4 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Kiessling and Hoyer as applied to claim 3 and further in view of U.S. Patent No. 6,487,869 (Sulc). Claim 5 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Kiessling in view of Hoyer and Sulc as applied to claim 4 and further in view of U.S. Patent No. 6,594,542 (Williams). Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over US2001/0024686 (Kiessling B) in view of U.S. Patent No. 3,959,520 (Hoyer). Claim 8 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Kiessling in view of Hoyer and Kiessling B as applied to claim 7 and further in view of US Patent No 4,208,454 (Reed).

Applicants have amended the claims to include the features of claims 2 and 3, therefore, the rejections based on Kiessling in view of Sulc, Williams, Reed and Kiessling B are now moot.

With regard to the rejections of claims 1-3, 6 and 9 based on Kiessling and Hoyer, Applicants respectfully traverse this rejection. To maintain a proper rejection under 35 U.S.C. §103, the Office must meet four conditions to establish a *prima facie* case of obviousness. First, the Office must show that the prior art suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process. Second, the Office must show that the prior art would have provided one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in an Applicant's disclosure. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Fourth, if an obviousness rejection is based on some combination of prior art references, the Office must show a suggestion, teaching, or motivation to combine the prior art

references (“the TSM test”). *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir 1999). Following *KSR Int’l Co. v. Teleflex, Inc.*, this fourth prong of the *prima facie* obviousness analysis must not be applied in a rigid or formulaic way such that it becomes inconsistent with the more flexible approach of *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966); 127 S. Ct. 1727 (2007). It must still be applied, however, as the TSM test captures the important insight that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 1741 (citing *United States v. Adams*, 383 U.S. 39, 50-52 (1966)). It is necessary to “show all of the limitations of the claims arranged or combined in the same way as recited in the claims.” *Net Moneyin v. Verisign*, 545 F.3d 1959, 1368 (Fed. Cir. 2008). Applicants respectfully submit that the prior art does not do this.

Kiessling does not make the current claims obvious. Kiessling merely teaches step a) of the current method, which is the method for producing the raw coating. Kiessling does not teach weighing the bodies before and after the coating operation and it can be seen from the description of Kiessling that the “excess coating suspension” is the same term for something different than in the present claims. In the Office Action, the Examiner refers to [0040] to conclude from the masses of the carrier being mentioned in this section of Kiessling that there must have been a weighing step since otherwise the mass would be unknown. However, section [0040] of Kiessling is an illustration of section [0039] and is a mere calculation example to explain what is meant by different terms using fictitious numbers, but not a real example and consequently no weighing was involved as currently claimed. In addition, Kiessling at sections [0039] and [0040] together with the figures show that Kiessling’s coating suspension is pumped into the carrier from below into the flow channels of open pored bodies up to a desired coating height (which is less than the entire height of the carrier), and the coating suspension is subsequently removed to form a coating on the inner wall of the flow channels. This is repeated with turning the carrier by 180 degrees and then coating the uncoated part of the carrier in an additional step, but this variant that is claimed in Kiessling is not of much interest to the present application. In the same way step a) of the present claims is carried

out, but this is done in such a way that the amount of coating suspension forming the coating on the inside walls of the flow channels is always greater than the target amount. In contrast thereto, when Kiessling mentions "excess coating suspension", Kiessling is talking about the coating suspension with which the flow channels are filled before it is removed to actually form a coating. It can also be seen from the present application, claim 1, step a) the first words defining that step a) is a coating operation: "(a) *coating a body* with...". However, if the flow channels are filled with a coating suspension as in Kiessling, it is evident that this is not a coating operation at this point in time, but only after removal of the coating suspension a thin film of it will cover the inside walls of the flow channels. This is also illustrated in figures 2 and 3 of Kiessling. In contrast to Kiessling, in the present application a coating according to Kiessling is produced in step a) of claim 1, and then the difference between the actual quantity is accomplished by weighing the open-pore body before and after the coating operation of step a) and comparing the difference with the target quantity, and the difference is then used to adjust the intensity, the duration or both of the re-suction step. This is done for each single carrier. This is neither taught nor suggested in Kiessling which merely teaches a coating method allowing adjustment of coating conditions once in the beginning and then applying the same process conditions to all carriers to be coated, without any possibility of determining the controlled variable in each case and to converge them to the command variable. Kiessling thus merely teaches an open-loop control. In contrast to Kiessling, the present claims relate to a closed-loop control that keeps track of the controlled variable by weighing, the controlled variable is compared to the command variable (the desired amount of coating) and is influenced in order to achieve an adjustment to the command variable (by an additional suction step). In the current application, each porous body will be weighed empty, coated by a conventional coating method (e.g., Kiessling) in such a way so as to always apply an excess coating, weigh again and then remove the excess by a second suction step, and the intensity, duration or both of the second suction step is adjusted to the magnitude of excess amount of coating. These steps are not made obvious by Kiessling.

Like Kiessling, Hoyer does not make the current claims obvious. Hoyer weighs the bodies before and after coating at weighing stations 5 and 8 (see Hoyer, Fig. 1), but Hoyer does not appreciate that excess coating in the flow channel can be removed. Consequently, Hoyer teaches to remove off-spec carriers by element removal means 17 (see Hoyer, Fig. 1 in combination with col. 8, lines 24-35). Hoyer explicitly teaches to remove bodies that "...may be underweight *or overweight* following the initial coating operation." (see Hoyer, col. 8, lines 29-30). Consequently, Hoyer teaches away from the current claims because an excess amount of coating is deliberately applied to the carriers according to claim 1 of the present application and thus only overweight bodies are produced, for which Hoyer merely teaches to deal with by removing them as off-spec products. For these reasons, if one of ordinary skill in the art was to combine Kiessling and Hoyer, one would not obtain the current claims. Accordingly, Applicants respectfully submit that the claims cannot be considered obvious over any of the cited references alone or in combination and request that the rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

4. Provisional Double Patenting Rejection

Claims 1-10 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of copending Application No. 11/665,591. Applicants respectfully disagree and submit that the newly amended claims are not obvious and request that the Examiner reconsider this rejection in light of the amendments made to the claims.

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U.S. Serial No: 10/553,359
U.S. Filing Date: February 4, 2008
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5. Conclusion

Applicants submit that the pending claims are allowable and respectfully request reconsideration and a notice of allowance to this effect.

No fee other than the enclosed fee for a three-month extension of time and Request for a Continued Application (RCE) is believed to be due with respect to the filing of this Response. If any further fees are deemed due, or an overpayment has been made, please charge, or credit, Deposit Account No. 11-0171 for such sum.

If the Examiner has any questions regarding the present application, the Examiner is cordially invited to contact Applicants' attorney at the telephone number provided below.

Respectfully submitted,



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